

DOCKET NO.: UPN-3904

REMARKS

Reconsideration of the present application in view of the above amendments and following remarks is requested respectfully.

Claims 20-22 and 27-32 are pending and stand rejected. Claims 20 and 28-32 have been amended, support for which can be found throughout the specification, as noted by the Office Action, for example, on page 12, lines 1-24.

I. Obviousness-Type Double Patenting Rejection

Claims 20-22 and 27-32 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 14-19 of U.S. Patent No. 5,540,908 to Koch et al. ("908 Patent"). Applicants maintain that the double patenting rejection is improper for the reasons stated in the Request for Reconsideration dated December 14, 2001. Notwithstanding, to facilitate prosecution and to obtain an early notice of allowance, Applicants have amended claim 20 as suggested by the Examiner. Accordingly, this rejection is moot.

II. Rejection under 35 U.S.C. § 112

Applicants respectfully disagree with the rejection of claims 20-22 and 27-32 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter not described in the specification in a manner sufficient to enable one skilled in the art to practice the invention. The subject matter defined in claim 20, and the claims dependent thereon, would be readily apparent to one of ordinary skill in the art, when read in light of the enabling specification. However, to facilitate prosecution and to obtain an early notice of allowance, Applicants have amended claim 20 to positively recite the presence of ¹⁸F.

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Claim 20 also stands rejected as allegedly being indefinite under 35 U.S.C. § 112, second paragraph. Applicants traverse this rejection and submit that one skilled in the art would find the claim both clear and definite with respect to the form of introduction of the claimed compound into a mammal. However, to facilitate prosecution and to secure an early allowance of the claims, Applicants have amended claim 20 as suggested by the Examiner.

In view of the above amendment and remarks, reconsideration and withdrawal of the rejections under Section 112 are requested respectfully.

III. Obviousness Rejection Under 35 U.S.C. § 103

Claims 20-22 and 27-32 also stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the '908 patent. Applicants respectfully traverse this rejection. Notwithstanding, in view of the above amendment and remarks, reconsideration and withdrawal of the rejection under Section 103 are requested respectfully.

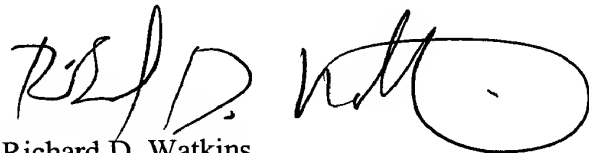
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IV. Conclusion

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

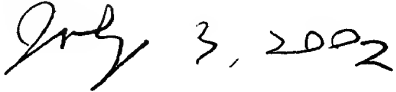
The foregoing represents a bona fide attempt to advance the present case to allowance. Applicants submit that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R.D. Watkins", followed by a large, loopy circular flourish.

Richard D. Watkins
Registration No. 50,993

Date:

A handwritten date in black ink, "July 3, 2002", written in a cursive style.

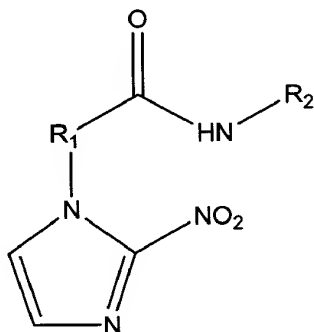
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VERSIONS WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Please amend the claims as follows:

20. **(amended)** A method for detecting tissue hypoxia in a mammal comprising: [introducing into] administering to the mammal a compound having the formula:



wherein R₁ is CH₂; and R₂ has the formula CH₂CX₂CHX₂, wherein X is halogen or hydrogen and at least 1 carbon atom of said alkyl group is bound with at least one [halogen atom] ¹⁸F; and imaging the portion pf the mammal containing the tissue.

28. **(amended)** The method of claim 20 wherein R₂ is CH₂CF₂CH₂¹⁸F.

29. **(amended)** The method of claim 20 wherein R₂ is CH₂CF₂CH¹⁸F₂.

30. **(amended)** The method of claim 20 wherein R₂ is CH₂CHFCH₂¹⁸F.

31. **(amended)** The method of claim 20 wherein R₂ is CH₂CHFCH¹⁸F₂.

32. **(amended)** The method of claim 20 wherein R₂ is CH₂CH₂CH¹⁸F₂.